

### REMARKS

In response to the Office Action mailed October 29, 2008, the Examiner's claim rejections have been considered. Applicants respectfully traverse all rejections regarding all pending claims and earnestly solicit allowance of these claims.

#### **1. Claim Objections**

The Examiner objected the use of the singular "indicium" as opposed to the plural "indicia" in claims 2, 3, 7, 8, 12 and 13. In response, Applicants have amended claims 2, 3, 7, 8, 12 and 13 as suggested by the Examiner.

#### **2. Claim Rejections – 35 U.S.C. § 103(a)**

The Examiner rejected claims 1-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tulley, et al. (U.S. Patent No. 7,179,168) in view of Nicastro (U.S. Patent Publication No. 2003/0027619). Applicants respectfully traverse this rejection. For the sake of brevity, the rejections of the independent claims 1, 6 and 11 are discussed in detail on the understanding that the dependent claims are also patentably distinct over the cited art, as they depend directly from their respective independent claims. Nevertheless, the dependent claims include additional features that, in combination with those of the independent claims, provide further, separate and independent bases for patentability.

Applicants respectfully submit that the combination of Tulley and Nicastro fails to disclose all the claimed elements. Specifically, as the Examiner admits, "Tulley does not specifically disclose [a] player terminal [that] is configured to determine a base game result and a bonus game play result from a single play result." Additionally, Nicastro fails to make up for the deficiencies of Tulley. The portion of Nicastro cited by the Examiner merely discloses, in part, that "many *variations* on the *basic* game and bonus game...are possible in keeping with the spirit and scope of the invention." There is no mention of a base game play result and bonus game play result determined from a single game play result. Applicants submit that determining a base game and bonus game result form a single play result is not a variation of the basic game. Furthermore, the spirit and scope of Nicastro relates to a base game allowing entry into a bonus game that permits player skill and/or player decisions to effect the outcome of the bonus game.

(See, Abstract and Summary of Invention). Player skill and/or decisions used to determine a bonus game outcome is inconsistent with a game in which base game and bonus game are determined from a single game play result. According to the claimed invention, a game player result is predetermined by a single game result, and no player skill or input will change the result of the game.

Additionally, the portion cited by the Examiner discloses, “[t]he particular graphical elements can be arranged differently or have a different appearance. The overall game theme can be different, such as a hound or a hare rather than a cat or mouse. The basic game can be any video game offering a winning combination that earns a bonus game entry combination, such as a video slot machine game, video poker, video blackjack, video keno, or the like.” However, this portion of Nicastro does not teach or disclose that a single game play result can be used to determine both a base and bonus game result. Rather, this section of Nicastro discloses that the appearance of the game (or types of basic games) may vary from the disclosed embodiments. It is unclear as to how this portion of Nicastro makes up for the deficiencies of the Tulley reference. The claimed invention provides a gaming system using a fixed pool of results to provide games in which a base game and bonus game may be presented to a player based upon a single game result sent from a central server. The claimed invention is not taught, suggested or disclosed by Tulley or Nicastro.

In addition to Nicastro failing to provide any enabling disclosure for the missing claimed element, Applicants submit that no motivation to combine Tulley and Nicastro is provided by the Examiner. The Federal Circuit has noted that even post-KSR<sup>1</sup>, some motivation for combining prior art references together. See, e.g., *Innogenetics, NV v. Abbott Labs*, 512 F.3d 1363 (Fed. Cir. 2008). The Examiner has not provided any motivation to combine the references together. Accordingly, Applicants can only surmise that the Examiner is simply using hindsight to reconstruct the claimed invention from the cited references, while using the claimed invention as a blueprint. This type of rational is still prohibited post KSR<sup>2</sup>, as was explained by the Federal Circuit in *Aventis Pharma Deutschland GmbH V. Lupin Ltd.*<sup>3</sup> when it stated, “We must still be careful not to allow hindsight reconstruction of references to reach the claimed invention without

<sup>1</sup> *KSR Int'l Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1395 (2007).

<sup>2</sup> *Id.*

<sup>3</sup> 499 F.3d 1293 (Fed. Cir. 2007).

any explanation as to how or why the references would be combined to produce the claimed invention.”<sup>4</sup>

In conclusion, Applicants respectfully submit that Tulley and Nicastro do not render the claimed invention obvious and respectfully request that the 35 U.S.C. § 103(a) rejection to claims 1-15 be withdrawn.

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<sup>4</sup> Id.

**CONCLUSION**


Applicants have made an earnest and *bona fide* effort to clarify the issues before the Examiner and to place this case in condition for allowance. Reconsideration and allowance of all of claims 1-15 is believed to be in order, and a timely Notice of Allowance to this effect is respectfully requested.

The Commissioner is hereby authorized to charge the fees indicated in the Fee Transmittal, any additional fee(s) or underpayment of fee(s) under 37 CFR 1.16 and 1.17, or to credit any overpayments, to Deposit Account No. 194293, Deposit Account Name STEPTOE & JOHNSON LLP.

Should the Examiner have any questions concerning the foregoing, the Examiner is invited to telephone the undersigned attorney at (310) 734-3200. The undersigned attorney can normally be reached Monday through Friday from about 9:00 AM to 6:00 PM Pacific Time.

Respectfully submitted,

Date: December 15, 2008

  
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